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IN THE

Supreme Court of the United States

October Term, 1973

No. 73-1567

DART INDUSTRIES INC.,

Petitioner,

v.

E. I. DuPONT DE NEMOURS AND COMPANY,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

BRIEF OF PETITIONER IN REPLY

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References to the Appendix to the Petition for Writ of Certiorari are indicated herein by a capital "A" followed by a page number.

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Whenever emphasis appears in this Reply, it has been added unless otherwise indicated.

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Statement

During and since the pendency of these proceedings in the Court of Appeals, certain facts and circumstances have arisen which Petitioner believes weigh significantly on the questions raised in its Petition relating to fundamental questions of judicial and due process.

Such questions, although raised in a private patent suit, are independently, Petitioner believes, of such stature and significance, in connection with the judicial process of adjudication of private rights, that they satisfy the requirements for review of matters of public concern and proper administration of justice.

This reply is made necessary because it is Petitioner's judgment that the respondent has, in its Answer, adopted the tactic of restating the questions so as to make it appear

that the questions on which review is sought are simply those originally presented to the Court of Appeals.

Argument

I. DuPont's Reliance on the Court Of Appeals' *De Novo* Findings Demonstrates the Injury and Prejudice Occasioned by the Procedure Followed by the Court of Appeals of Which Petitioner Complains Herein.

Respondent does not deny or rebut the following cited and documented facts (P9-10):

> —that the "orifice" tests were performed in the Carver die in 1946, four years before Bradt even *conceived* his invention, with a material which was clearly *not* the one described and claimed in the Bradt patent;
>
> —that the parties agreed such 1946 tests did not constitute a reduction to practice of the invention and thus never raised any issue with respect to this subject before the District Court or the Court of Appeals;
>
> —that Bradt did *not* overcome the Malinowski reference by establishing an actual reduction to practice prior to April 25, 1951, *but* by demonstrating a prior conception coupled with diligence to a subsequent reduction to practice in January 1952;
>
> —that the parties *agreed* Bradt had overcome the Malinowski reference in the above manner and likewise never contested any issue with respect to this subject before the District Court or the Court of Appeals.

Having avoided these facts DuPont then argues (R5):

> "In deciding that the invention was complete, the Court [of Appeals] did not rely upon any finding that 'orifice tests' made in 1946 constituted a reduction to practice of Bradt's invention. In fact the Court made no such finding at all."

However, that the Court of Appeals unquestionably relied upon such independent factual finding upon a *de novo* issue and did so contrary to the overwhelmingly contrary and undisputed record, is plainly evident from the relevant portions of the September 21, 1973 decision:

> "When the sales were consummated, *the invention had already been reduced to practice but the product had not yet been tested in an injection molding machine;* each of the four customers indicated that its purchase was for experimental purposes." (A42)
>
> * * *
>
> "Bradt satisfied himself that *his product* could be readily fed into a machine by conducting a series of tests in which *he forced the mixture through an orifice* of the size used in injection molding machines and molds. Since the glass did not clog the orifice Bradt concluded that *the product* was satisfactory for injection molding. *On the basis of these tests,* Bradt claimed that there had been a sufficient reduction to practice in December, 1950, *to avoid a reference* dated April 25, 1951, which had been cited by the Patent Examiner." (A43-45)
>
> * * *
>
> "In this case the product which was sold underwent no significant change after the disqualifying sales occurred. *It had already been sufficiently reduced to practice to avoid the reference dated April 25, 1951;* and it subsequently achieved commercial success in the form in which it was sold. *More significantly,* even though Bradt's laboratory tests could not guarantee ultimate commercial acceptance, *they were sufficient to demonstrate the workability of his conception.* The prior art diced mat clogged the injection molding machine because it would not satisfactorily pass *through the orifice. Bradt's tests demonstrated that his granules would not clog the machine."* (A51)
>
> * * *
>
> ". . . *we hold* that the unrestricted sales to four different purchasers *after the invention had been*

> *reduced to practice sufficiently to avoid an important reference cited by the Examiner* and more than one year before the patent application was filed, precluded the allowance of the claims in suit." (A54)*

If the above-quoted findings that Bradt tested the product of his invention in the orifice test and thereby established the workability of his conception and reduced his invention to practice sufficiently to avoid the Malinowski reference were not made on an independent *de novo* basis by the Court of Appeals, this Court should note that DuPont has failed to cite the trial record where such issues were in any manner presented to, considered or determined by the District Court, or to cite the record where either party presented any such factual or legal issues for review to the Court of Appeals prior to its September 21, 1973 decision.

Dart presented in the Addendum to its Petition all of the record testimony, exhibits and excerpts from briefs which had in any way mentioned the orifice test and avoidance of the Malinowski reference prior to the September 21, 1973 decision of the Court of Appeals. It demonstrates beyond question the *de novo* nature of the critical findings reached upon such issues by the Court of Appeals. DuPont has not rebutted Dart's showing that such issues were determined *de novo* and relied upon by the Court of Appeals as the basis for its reversal of the District Court.

DuPont attempts *now* to argue the correctness of the Court of Appeals findings. This illustrates the fundamental unfairness and serious prejudice that have arisen from the

---

* Although this holding is critical and is based squarely upon the erroneous finding that the inventor avoided the Malinowski reference by establishing a prior *reduction to practice,* DuPont could not bring itself to support it anywhere in its answer to the Petition. The reason for such an anomalous omission resides in the singular fact that the Respondent agreed exactly to the contrary in its brief before the Court of Appeals (p. 20):

> "In a series of affidavits, Bradt averred that he had *thought of* the roving granule *before Malinowski's filing date* and *had pursued the idea with diligence* (PX2, pp. 44-52, 64-68, 85-92). *Having thus avoided the Malinowski patent,* * * *"

failure to observe due process safeguards in this case. DuPont *now* argues that Bradt's 1946 orifice tests *were* in some manner associated with the roving granules of his invention conceived in 1950 (R6). At no time prior to the Court of Appeals *de novo* findings with respect to the orifice test did Dart have to address itself to such a contention, DuPont's prior position having been:

> "The Carver die [orifice test] doesn't relate to those [roving samples]. I am not implying that it does." (P 1a, A168)

DuPont argues *now* that Bradt was referring to both his 1946 and 1950 tests in an affidavit presented to the Patent Office when he purportedly knew and represented that his roving granules would be satisfactory for injection molding, citing the patent file wrapper "PX 2, *pp. 65, 86*" (R6). However, Dart, prior to the September 21, 1973 *de novo* finding of the Court of Appeals, faced only the agreement by DuPont that the *identical* file wrapper citations were part of Bradt's showing of *conception and diligence, not completion of the invention,* prior to Malinowski's filing date (*supra* p. 4n):

> "In a series of affidavits, Bradt averred that he had thought of the roving granule before Malinowski's filing date and had pursued the idea with diligence (PX 2, pp. 44-52, *64-68, 85-92*)."

Finally, DuPont *now* attempts to argue that it was upon the basis of *both* the 1946 and 1950 tests, and with his roving granules in hand, that Bradt contended that his affidavits had established a reduction to practice in December 1950, citing and quoting incompletely from PX 2, *p. 80* (R7). Prior to the September 21, 1973 *de novo* findings of the Court of Appeals, however, Dart faced instead the contention that the *identical* file wrapper citation was part of Bradt's *diligence showing, not any reduction to practice.* Moreover, the complete quotation refers only to the *making*

of Bradt's first roving samples in December 1950, which the Examiner immediately and affirmatively rejected as a reduction to practice, and *not* to any orifice test as DuPont infers (PX2, *p. 80*):

> "As to reduction to practice, applicant submits that the affidavits establish reduction to practice in December, 1950, of the subject matter of claims drawn to the molding material; *for at that time* glass roving was passed through a polystryrene bath and then through an oven to drive off the water of the latex and cure the resin residue."

The fact is that neither the District Court nor the Court of Appeals was called upon to consider and determine any conflict between the parties on the questions of the orifice tests and the avoidance of the Malinowski reference, such as first arose after the September 21, 1973 *de novo* findings of the Court of Appeals and now confront this Court. The wisdom and crucial importance of the fundamental due process guarantees of due notice and a meaningful opportunity to be heard before the trier of fact is convincingly demonstrated by the real quandry in which Dart now finds itself, where it faces facile reversals of position by its adversary on issues of fact which neither party urged as a basis for reversal or as being in contest and upon which Dart has had no meaningful opportunity to know the evidence to be considered and to test, explain or refute it. *Int. Com. Comm.* v. *Louis & Nash R. R.*, 227 U.S. 88, 93 (1913); *In re Augenbaugh*, 125 F.2d 887, 889 (3d Cir. 1942).

There can be no doubt that if Dart had been notified at trial that DuPont would assume its present stance, based not on the trial record but upon the *de novo* determination, it would have elicited testimony from the inventor and others to establish the relevant facts, and especially that of the Examiner who regarded the relationship of the 1946 orifice tests to the question of completion of the invention of the Bradt patent to be: *"Conjecture"*,

"This is not invention claimed and not completed", and who regarded *all* of Bradt's laboratory tests preceding the first trial of the product of his invention in an actual injection molding machine in January 1952, within one year of the filing of his patent application, to be: "At most *only conception.* Where was it done?", *"No red. to practice"*, "11 or 12/1950-1952 *Diligence?"*, *"No TEST"* and "too indefinite as to material. *Also no evidence it was tried."* That evidence of such material significance and weight was not adduced at trial speaks compellingly of the fact that the subject matters to which it relates were not at that time being contested. DuPont has not even attempted to contend otherwise, much less present evidence to the contrary. The deprivation of Dart's due process rights to notice and a meaningful opportunity to be heard upon *de novo* issues not litigated or determined prior to the September 21, 1973 decision of the Court of Appeals can be neither denied on the record herein nor justified as a matter of law.

II. DuPont's Characterization of the Effect of Judge Stevens' Disqualification Renders the Disqualification Meaningless.

DuPont does not challenge the efficacy or vitality of the legal principles which support Dart's position that participation of a disqualified judge in the determination of this appeal constituted a denial of due process of law. Instead, it advances the novel theory that since, in its opinion, the circumstance which caused Judge Stevens to disqualify himself was not such as to have *required* such action, the disqualification was effective only prospectively and thus did not invalidate his earlier decision.

The approach suggested by DuPont is, of course, without support in the relevant statutes or reported judicial decisions. Such an approach ignores the inherently subjective nature of the decision making process which has been recognized historically and has prompted this Court

wisely to insist upon the avoidance of not just *actual* judicial basis or partiality but *any possibility* of such bias. *In re Murchison,* 349 U.S. 133, 136 (1955); *Commonwealth Corp.* v. *Casualty Co.,* 393 U.S. 145, 150 (1968).

There can be no dispute that under the terms of 28 U.S.C. § 455, the present circumstances were such as to leave the determination of disqualification to the discretion and conscience of Judge Stevens; nor can it be contested that his determination is not to be disturbed in the absence of abuse of discretion. *Voltmann* v. *United Fruit Co.,* 147 F.2d 514, 517 (2d Cir. 1945). He has established the fact of disqualification—one existing at the time the original opinion was authored by him. Thus, whatever views Dart or DuPont may hold with respect to the substance of the disqualifying circumstances are of no importance. The only significant facts are that *Judge Stevens considered it sufficient to warrant disqualification* and he so acted, advising the other members of the panel (A92):

> "• • • it is *perfectly clear* that if I had known of this circumstance, I would have disqualified myself, and I believe *the duty to do so arises when a disqualifying circumstance becomes known.* • • • May I respectively suggest that the next order entered in this litigation carry a notation stating in substance 'On October 29, 1973, Judge Steven *became aware* of a disqualifying circumstance and did not thereafter participate in deliberations concerning this litigation.' • • •"

Moreover, it can only be presumed that at the time he determined to excuse himself, Judge Stevens also had in mind his equally strong judicial duty not to withdraw in the absence of a valid reason for so doing. See: *Laird* v. *Tatum,* 409 U.S. 824, 837 (1972).* Accordingly, there can

* In the light of the fact that Judge Stevens was the one member of a panel most qualified to recognize his own error and keeping in mind that he had determined that the Petition For Rehearing/Remand had made a *prima facie* showing, his withdrawal could have seriously prejudiced Dart in the prospective aspect of a rehearing.

be no doubt that *in the mind of Judge Stevens* the present disqualifying circumstance was at least of *equal significance* as the particular circumstances specified by 28 U.S.C. § 455. What then can be the rationale for applying DuPont's artificial distinction between the two statutory classes of disqualifying circumstances other than to establish an arbitrary basis for determining retroactive effect?*

The issues raised by Judge Stevens' voluntary disqualification cannot be resolved by the rote application of mathematical formulae. In truth, it is impossible now to ascertain the effect of the pre-existing disqualifying circumstance upon the subconscious mind of Judge Stevens as he formulated his views with respect to this appeal. As Mr. Justice Frankfurter, concurring in *Pennekamp* v. *State of Florida,* 328 U.S. 331, 337 (1946), observed:

> " * * * judges are also human, and we know better than did our forebears how powerful is the pull of the unconscious and how treacherous the rational process."

Most apposite are the remarks of Mr. Justice Cardozo, who spoke of "The Subconscious Element in the Judicial Process" as follows:

> "I have spoken of the forces of which judges avowedly avail to shape the form and content of their judgments. Even these forces are seldom fully in consciousness. They lie so near the surface, however, that their existence and influence are not likely to be disclaimed. * * * *Deep below consciousness are other forces,* the likes and the dislikes, the predilections and the prejudices, the complex of instincts and emotions, which make the man, *whether he be litigant or judge."***

Nor can anyone now determine the extent of Judge Stevens' influence upon the other members of the panel which presumably was considerable since, as the opinion-

* See: Brief of Respondent In Opposition, pp. 9-10.

** Hall's Selected Writings of Benjamin N. Cardozo, p. 178.

writer, he apparently bore the primary burden of studying the record and arriving at the results. Although the Court of Appeals for the Seventh Circuit has not to date made public the procedures which its judges follow in determining appeals, the Third Circuit has recently published its "Internal Operating Procedures" which, in relevant part, clearly evidence the dominant role of the opinion-writing judge:

> "F: The opinion-writing judge prepares a draft opinion in accordance with the decision of the panel at conference *or expressing any different views which he has reached after his* subsequent study of the case. * * * "
>
> "I.1: * * * After the draft has been prepared the opinion-writing judge circulates it * * * to the other two members of the panel with a request for approval or suggestions they may desire to make * * * ."

DuPont's proposed solution does not allow for the fact that the disqualifying circumstance did not spring forth on October 29, 1973 but existed throughout the pendency of this appeal. Nor does it provide for the fact that Judge Stevens is a human being who, throughout his deliberation, was subject to the subconscious influence of a factor whose mere presence altered his rational processes in a manner which can never be determined. So signficant was this factor *in his opinion* that he immediately disqualified himself upon becoming consciously aware of it. No arbitrary formula can erase what has occurred. Nothing less than the vacating of the judgment of the Court of Appeals will be sufficient to discharge the constitutional requirements that "justice must satisfy the appearance of justice" *Offutt* v. *United States,* 348 U.S. 11, 14 (1954), and "* * * any Tribunal permitted by law to try cases and controversies not only must be unbiased but also must avoid even the appearance of bias." *Commonwealth Corp.* v. *Casualty Co., supra at* 150.

Conclusion

No degree of "strained argument" is necessary or has been presented by Dart to demonstrate the manifest denials of its most fundamental and constitutional rights of due process as a litigant before the Court of Appeals for the Seventh Circuit.

Therefore, the Petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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Certificate of Service

This Brief of Petitioner in Reply has been served upon Respondent by air mailing three copies thereof to Frank Fowle, Esq., Pope, Ballard, Shepard & Fowle, 69 West Washington Street, Chicago, Illinois, 60602 this 24th day of May, 1974.

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